

## REMARKS

In the Non-Final Office Action of September 26, 2008, it is alleged that the application contains claims directed to three groups which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicant respectfully disagrees with the characterization of the claimed invention and the restriction is hereby traversed.

As a formality to comply with 35 U.S.C. 121 and 372, Applicant provisionally elects Group II corresponding to claims 26 - 40 for an examination on the merits.

It is Applicant's position that the claims 1-25, 26-40 and 41-46 are of a single general inventive concept under PCT Rule 13.1. The Examiner supposes that the subject matter of the pending claims is not novel in light of EP Patent Application No. 0 786 380 A1 to Duriez ("Duriez") and U.S. Patent No. 5,811,053 to Ota et al. ("Ota"). (See 9/26/2008 Office Action, pp. 2-3)

It is respectfully submitted that the Restriction Requirement is in error since Duriez and Ota do not disclose the novel technical features of claims 1, 26 and 41. According to 37 CFR 1.475, a special technical feature is any common element that defines a contribution over the prior art. Specifically, a common technical feature between claims 1, 26 and 41 is the limitation of a first region formed *exclusively* of a decor inlay and comprising an edging *enclosed* by the cast skin as described above is a novel attribute over the surface decor disclosed in the prior art.

Duriez discloses a skin 4 that is placed over a portion 1 such that a foot 7 of the portion 1 remains exposed on lateral sides thereof. (See Duriez, col. 2, li. 54 – col. 3, li. 49; Figs. 1 - 3). Thus, Duriez does not teach a first region formed exclusively of decor inlay. Technical features of the claims of the present invention require a side by side arrangement wherein the decor inlay lies laterally adjacent to the cast skin with only an edging thereof being housed within the cast skin. Specifically, only the aforementioned side by side arrangement would permit conformation to the limitations of claim 1, wherein *only* an edging of the first region comprising only the decor

inlay contacts the cast skin, as those skilled in the art will understand. Duriez, on the other hand, teaches an embodiment where the cast skin lies *over* the decor inlay so that there is no region formed exclusively of the decor inlay. It is therefore respectfully submitted that Duriez does not teach the novel technical feature of “*a first region formed exclusively by a decor inlay, an edging of the decor inlay bordering a second region of the surface decor which is formed by the cast skin, the edging of the decor inlay being enclosed by the cast skin,*” as recited in claim 1.

Claim 26 recites that the decor inlay is placed into a space between upper and lower casting tools and the cast skin is placed into a cavity between the upper and lower casting tools, wherein an edge of the decor inlay is enclosed by the cast skin. It is inherent that such a method may only be performed when the decor inlay and cast skin are formed laterally adjacent to one another, connected only by the edging. This recitation corresponds to the technical features of claim 1 as recited above. Specifically, contrary to the system of Duriez, claim 26 does not teach an overlapping of the decor inlay and cast skin at all. It is therefore submitted that claim 26 recites substantially the same technical features as claim 1 and Duriez thus fails to teach a method comprising “*clamping an edging of the decor inlay between the upper and lower tools with a curing material to form a cast skin enclosing the edging after the decor inlay has been clamped between the upper and lower tools,*” as recited in claim 26.

Claim 41 recites a casting tool for manufacturing a surface decor for a trim part, comprising: “upper and lower tools which, when closed against one another, form a cavity therebetween, the upper and lower tools being movable toward and away from one another to open and close the cavity, *wherein a first region of the cavity forms a space for the introduction thereto of a curing material to form a cast skin and a second region of the cavity forms a space for receiving therein a decor inlay, the first and second regions bordering one another along a sealing gap within which an edging of the decor inlay is clamped when the upper and lower tools are closed against one another,* wherein the casting tool at the sealing gap is widened towards the cavity so that the edging of the decor inlay bears on edges of the sealing gap but not on walls of the cavity.” It is therefore submitted that claim 41 also discloses the aforementioned novel

technical feature of a first region formed exclusively of a decor inlay and comprising an edging enclosed by the cast skin.

The Ota device is formed substantially similarly as the device of Duriez, wherein an ornamental surface 40 and skin member 30 are placed over a resin core member 20 so that only a portion of the resin core member 20 is exposed. (See Ota, col. 5, ll. 1 - 37; Fig. 2). Ota also does not teach a first region formed *exclusively* of a decor inlay, the decor inlay comprising an edging *enclosed* by the cast skin as described in claims 1 and 26. It is therefore submitted that the recited features of claims 1, 26 and 41 are also novel over Ota.

Accordingly, in view of the above reasons, it is respectfully submitted that each of independent claims 1, 26 and 41 is directed to a single general inventive concept and that the restriction is improper. It is therefore respectfully requested that the restriction requirement be withdrawn and the claims be examined on the merits.

If the Examiner disagrees with the above arguments, the Examiner is respectfully requested to reject the claims for the second time to allow Applicant an opportunity to petition the Restriction Requirement.

An earnest effort has been made to be fully responsive to the Office Action and advance the prosecution of this case. If there are questions, the Examiner is respectfully requested to call the undersigned attorney at the number listed below.

Respectfully submitted,

Dated: October 27, 2008

  
By: \_\_\_\_\_

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